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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,799	02/08/2007	Philip Head	23615	5840
535 7590 03/06/2008 K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900				
EXAMINER				
BUCK, MATTHEW R				
ART UNIT		PAPER NUMBER		
3671				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,799

Applicant(s)

HEAD, PHILIP

Examiner

MATTHEW R. BUCK

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 05/09/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 4-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Head (U.S. Patent #5472052).
3. As concerns claims 1, 2 and 5, Head shows a method of abandoning a well, comprising at least two concentric conduits, comprising the steps of: providing a perforation, pumping out the fluid, and inserting sealing material (column 2, lines 11-42).
4. As concerns claim 4, Head shows wherein the fluid is pumped downwards into the well (column 5, lines 1-3).
5. As concerns claims 6 and 7, Head shows wherein perforations are formed in at least one conduit and the annular chamber is sealed at various levels between the conduits (column 2, lines 43-65; column 3, lines 19-29; column 4, lines 36-57).
6. As concerns claim 8, Head shows an apparatus for abandoning a well having at least two concentric conduits, including a pump and a perforation forming device (column 3, lines 34-37).
7. As concerns claim 9, Head shows a check valve to permit one way flow of fluids (column 2, line 66 - column 3, line 4).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Head as applied to claims 1 and 8 above, and further in view of Bohn (U.S. Patent #3939927).

10. As concerns claim 3, Head lacks to show wherein a tube is introduced and the fluid is pumped to the surface through the tube. However, Bohn teaches the elements of claim 3 (Fig. 1, 11 and Fig. 2; column 2, lines 49-52). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn because a tube is known to provide a direct and effective way to pump fluid to the surface.

11. As concerns claim 11, Head lacks to show a cable. However, Bohn teaches the elements of claim 11 ([’052: column 7, lines 25-28]; [’927: Fig. 1, 11; column 2, lines 26-29]). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn because a cable is known to provide a means of lowering an apparatus into a well.

12. As concerns claim 12, Head lacks to show wherein the perforation forming device is incorporated into the pump. However, Bohn teaches the elements of claim 12 ([’052: column 3, lines 34-37]; [’927: Fig. 2, 31 and 22]). One of ordinary skill in the art

at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn because the combined structure is known to reduce the needed equipment to abandon a well.

13. As concerns claim 13, Head lacks to show wherein the perforation forming device is incorporated into the valve unit. However, Bohn teaches the elements of claim 13 (Fig. 2, 31, 28 and 29). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn because the combined structure is known to reduce the needed equipment to abandon a well.

14. As concerns claim 14, Head lacks to show wherein the cable includes a through bore. However, Bohn teaches the elements of claim 14 (Fig. 1, 11 and Fig. 2). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn because a cable with a bore is known to provide means for either fluid or other cables to be drawn through it.

15. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made since this configuration improves versatility of an apparatus for abandoning a well.

16. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Head as applied to claim 8 above, and further in view of Bohn.

17. Bohn shows wherein the pump and the valve unit are together. Note that it has been held that constructing a formerly integral structure in various elements involves

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only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Further, MPEP § 2144.04 states: In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.").

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW R. BUCK whose telephone number is (571) 270-3653. The examiner can normally be reached on Monday through Friday 7:30am - 5:00pm E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on (571) 272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas A Beach/
Primary Examiner, Art Unit 3671

mrb